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8 **UNITED STATES DISTRICT COURT**  
9 **NORTHERN DISTRICT OF CALIFORNIA**  
10 **SAN JOSE DIVISION**

11  
12 ZINUS, INC. a California Corporation,

13 Plaintiff,

14 v.

15 SIMMONS BEDDING COMPANY, a  
16 Delaware corporation, and DREAMWELL,  
17 LTD., a limited liability company of  
Nevada,

18 Defendants.

19  
20 Case No. 07-CV-03012-PVT

**DREAMWELL'S SURREPLY BRIEF RE  
HYPOTHETICAL CLAIM ANALYSIS PER  
COURT'S JANUARY 17, 2008 INTERIM  
ORDER**

**Date:** February 19, 2008  
**Time:** 10:00 a.m.  
**Before:** The Honorable Patricia V. Trumbull  
**Location:** Courtroom 5

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AND RELATED COUNTERCLAIMS

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## Introduction

In its Opposition to Dreamwell’s Brief re Hypothetical Claim Analysis (the “Hypothetical Claim Opposition”), Zinus does not dispute that the hypothetical claim proposed by Dreamwell is broader than the original claim. Zinus also implicitly concedes (based on its failure to address the issue) that the hypothetical claim is broad enough to literally cover the Zinus Swirl Wrap process. Moreover, Zinus does not argue that the prior art Magni patent anticipates the hypothetical claim. Instead, Zinus bases its Opposition on the proposition that the Patent Office would not have allowed the hypothetical claim to issue because it would have been invalid under 35 U.S.C. § 103(a) or 112.

Zinus’ assertion that the hypothetical claim would have been rejected as obvious in light of the Magni patent is unfounded. Dreamwell has identified at least three differences between the hypothetical claim and the Magni patent that render the hypothetical claim non-obvious: 1) the hypothetical claim discloses a method of compressing pocketed coil innerspring mattresses, while the Magni patent makes no such disclosures; 2) the hypothetical claim discloses a “solid cover or barrier of flexible material that substantially covers the exposed surface of the mattress assembly,” while the Magni patent does not; and 3) the hypothetical claim discloses a “pre-cut” cover or barrier of flexible material, and there is no similar disclosure in the Magni patent. Although Zinus disputes the existence and significance of these differences, at the very least there are triable issues of fact regarding the disclosures of the Magni patent and the factual issues underlying any obviousness determination that would preclude resolving these issues on summary judgment. *See Wright Medical Tech., Inc. v. Osteonics Corp.*, 1999 WL 130578 (D. Mass. 1999) (denying summary judgment on a “practicing the prior art” defense; court found that a dispute over the disclosures of prior art references “cannot be resolved on a motion for summary judgment”).

Zinus' argument that the hypothetical claim would be invalid under 35 U.S.C. § 112 is equally without merit. Indeed, the only court to directly consider the issue has held Section 112 to be inapplicable as a matter of law in the context of a hypothetical claim analysis. *See Wright*

*Medical, supra* (rejecting the very argument now advanced by Zinus). The hypothetical claim analysis thus confirms that it would be improper for the Court to grant summary judgment of non-infringement based on Zinus' "practicing the prior art" defense.

## Argument

**I. THE COURT CANNOT FIND AS A MATTER OF LAW THAT THE HYPOTHETICAL CLAIM WOULD HAVE BEEN REJECTED AS OBVIOUS IN LIGHT OF THE MAGNI PATENT.**

Zinus acknowledges (as it must) that “to make [a] hypothetical claim obvious, the court must find that ‘the differences between the subject matter sought to be patented [i.e., the hypothetical claim] and the prior art are such that ***the subject matter as a whole*** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *Abbott Labs v. Dey*, 287 F.3d 1097, 1106 (Fed. Cir. 2002) (emphasis in original) (citing 35 U.S.C. § 103(a)). Zinus also does not and cannot dispute that “a determination of obviousness requires resolution of four underlying factual issues: 1) the scope and content of the prior art; 2) the differences between the prior art and the claims; 3) the level of ordinary skill in the pertinent art; and 4) objective evidence of nonobviousness,” such as commercial success, long-felt need, and unexpected results. *See Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1355-56 (Fed. Cir. 2007) (citing *KSR International Co. v. Teleflex Inc.*, \_\_\_\_ U.S. \_\_\_, 127 S. Ct. 1727, 167 L.Ed.2d 705 (2007)).

As explained in Dreamwell's opening Hypothetical Claim Brief, there are several significant disputes between the parties regarding these underlying factual issues, including but not limited to the overall scope and content of the Magni patent; whether the Magni patent discloses a method of compressing and packaging pocketed coil innerspring mattress assemblies; the significance of this limitation; whether one of ordinary skill would have been motivated or otherwise inclined to extend the Magni patent process to pocketed coil innerspring mattress assemblies; whether the application of the methods of the hypothetical claim to pocketed coil innerspring mattress assemblies would have yielded unexpected results; whether the Magni patent discloses a cover or barrier of flexible material that substantially covers the exposed surfaces of

1 the compressed mattress; whether the Magni patent discloses the use of a “pre-cut” film to  
 2 prevent the compressed mattress from expanding during shipping; the significance of this  
 3 limitation; whether one of ordinary skill would have been motivated or otherwise inclined to  
 4 utilize pre-cut covers or barriers of material to hold the compressed mattress, rather than  
 5 continuous rolls of ribbon-shaped film; and various factual issues underlying these questions.

6       While Zinus offers its own facts and argument to counter Dreamwell’s evidence, its  
 7 offerings do nothing more than highlight the existence of triable issues of fact. Those disputed  
 8 factual issues render summary judgment inappropriate on the issue of ensnarement or “practicing  
 9 the prior art.” *See, e.g., Bose Corp. v. JBL, Inc.*, 98 F. Supp. 2d 80 (D. Mass 2000) (denying  
 10 defendant’s motion for summary judgment on ensnarement defense where parties disputed the  
 11 disclosures of prior art references); *Wright Medical, supra*, 1999 WL 130578 (D. Mass. 1999)  
 12 (denying summary judgment on a “practicing the prior art” defense; court found that a dispute  
 13 over the disclosures of prior art references “cannot be resolved on a motion for summary  
 14 judgment”).<sup>1</sup>

15       A. **There Are Disputed Issues of Fact Relating to the Content of the**  
**Magni Patent and the Nature and Significance of the Differences**  
**Between the Magni Patent and the Hypothetical Claim, Taken as a**  
**Whole.**

16       As Dreamwell’s opening Hypothetical Claim Brief explained, the scope and teachings of  
 17 the prior art are questions of fact, and a dispute over what the prior art discloses precludes entry  
 18 of summary judgment on an ensnarement defense. *See, e.g., Mars, Inc. v. Coin Acceptors, Inc.*,  
 19 1996 WL 34385063, at \*5 (D.N.J. 1996) (holding that where there is a factual disagreement  
 20 regarding what the relevant prior art teaches, “the Court cannot summarily resolve the legal  
 21 question of whether the prior art anticipated or rendered obvious [the proposed] hypothetical  
 22 claim”), *citing Jurgens v. McKasy*, 927 F.2d 1552, 1560 (Fed. Cir. 1991). Secondary  
 23 considerations of non-obviousness, such as commercial success, long-felt need, and unexpected  
 24 results, are additional factual issues that, if disputed, cannot be resolved in the context of a  
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<sup>1</sup> Dreamwell notes that Zinus’ Opposition does not discuss or address in any way the  
 27 cases cited in Dreamwell’s moving papers. 3

1 hypothetical claim analysis. *See Mars, supra.* As the *Mars* court observed, “without first trying  
2 the factual questions upon which obviousness and anticipation are premised, the Court cannot say  
3 whether infringement by equivalency would improperly expand the scope of protection set forth  
4 in” the asserted claims. *Id.*

5 It is clear under these legal principles that on the facts of this case, the Court cannot  
6 summarily resolve whether the Magni patent would have rendered obvious the proposed  
7 hypothetical claim.

**1. The Magni Patent Does Not Disclose a Mattress Assembly Constructed of Coil Springs Wherein Each Spring Is Contained Within an Individual Pocket of Fabric.**

10 Zinus seems to acknowledge at pages 5-6 of its Hypothetical Claim Brief that the Magni  
11 patent does not explicitly disclose compressing a mattress constructed of pocketed coil springs.  
12 Zinus contends, however, that the Patent Office has already concluded that limiting the subject of  
13 the patented method to an innerspring mattress assembly with individual pocket coils makes no  
14 difference to patentability. The prosecution history does not support Zinus' claim.

15 Zinus notes that the Patent Office issued a “Final Office Action” rejecting the claims as  
16 obvious even after they were amended to specify that the claimed method would apply only to  
17 pocketed coil innerspring mattresses. Zinus ignores the rest of the story, however. Specifically,  
18 as noted in Dreawmwell’s initial Hypothetical Claim Brief, the inventors submitted an  
19 Amendment After Final Rejection in which they included (among other modifications) an  
20 amendment narrowing the type of material to be packaged from “an assembly of coil springs  
21 wherein each spring is contained within an individual pocket of fabric” to “a mattress assembly  
22 constructed of coil springs wherein each spring is contained within an individual pocket of  
23 fabric.” [Declaration of Darien K. Wallace in Support of Zinus, Inc.’s Motion for Summary  
24 Adjudication of Non-Infringement, filed in this action on October 2, 2007 (“Wallace Decl.”),  
25 Exh. W-F] As Dreamwell also pointed out in its opening brief (and as Zinus also ignores in its  
26 Opposition), the inventors also submitted argument in which they sought to “traverse” (or  
27 overcome) the objections by identifying analytical errors in the Examiner’s earlier analysis with

1 respect to this limitation, and “not[ing] with some concern that no mention is made in the instant  
 2 Office Action of the previously filed Rule 132 Declaration of inventor Rickey F. Gladney” setting  
 3 forth evidence of unexpected results. *[Id.]* After these amended claims were refiled as part of a  
 4 continuation application, the Patent Office allowed the claims to issue as U.S. Patent No.  
 5 5,622,030, the predecessor to the ‘142 Patent. *[Id.]*

6       Taking the prosecution history as a whole, it is impossible to conclude (as Zinus does) that  
 7 the Patent Office ultimately determined that the specific application of the claimed packaging  
 8 process to a pocketed coil mattress is irrelevant to patentability. Although the Examiner *initially*  
 9 made comments to that effect, the Examiner ultimately issued the claims after receiving renewed  
 10 argument from the inventors traversing the obviousness rejection. The Notice of Allowance did  
 11 not explain why the claims were ultimately allowed. Thus, while it is possible the Examiner  
 12 permitted the claims to issue as a result of one or more of the Amendments, it is also possible that  
 13 the Examiner reconsidered and reversed his prior conclusion in light of the inventors’ renewed  
 14 arguments.

15       In any event, Dreamwell is not arguing that the application of the patented method to  
 16 pocketed coil innerspring mattresses – alone and in isolation -- renders the hypothetical claim  
 17 non-obvious in light of the Magni patent. Rather, Dreamwell is arguing that this difference  
 18 between the hypothetical claim and the Magni patent, combined with the other differences  
 19 between the hypothetical claim and the Magni patent, and viewed in the context of the claim as a  
 20 whole and in light of the evidence of secondary consideration of non-obvious, makes the  
 21 hypothetical claim patentable over Magni. *See Abbott Labs, supra.*

22       Rather than adopting Zinus’ simplistic analysis, the Court must analyze the evidence as a  
 23 whole and make its own assessment on the legal question of obviousness. *See, e.g., Tyler*  
*24 Refrigeration Corp. v. Kysor Industrial Corp.*, 777 F.2d 687 (Fed. Cir. 1985). Given the  
 25 numerous and fundamental disputes on the underlying factual issues identified by Dreamwell, it  
 26 would be premature for the Court to resolve the obviousness of the hypothetical claim as a matter  
 27 of law at this early stage of the case, without further development of the factual record. *See Mars,*  
 28

1       *supra*. (denying summary judgment on hypothetical claim analysis where dispute existed over the  
 2       existence and significance of differences between prior art and hypothetical claim).

3       **2. There Is at Least a Triable Issue of Fact as to Whether the**  
 4       **Magni Patent Discloses Inserting the Compressed Mattress into**  
 5       **a “Solid Cover or Barrier of Flexible Material that**  
 6       **Substantially Covers the Exposed Surface of the Mattress**  
 7       **Assembly.**

8       As shown in Dreamwell’s opening Hypothetical Claim Brief, substantial evidence  
 9       supports Dreamwell’s assertion that the Magni patent discloses rolling up the mattress with a  
 10      slender, “ribbon shaped film 222” that does not cover or surround a substantial portion of the  
 11      exposed surface of the mattress. That evidence includes at least the following:<sup>2</sup>

- 12       •       the Magni patent uses the term “ribbon-shaped film” on at least 16  
 13       occasions to describe film 222, the film in which the Magni mattress is  
 14       rolled up;
- 15       •       the term “sheet of film,” which Zinus uses to characterize film 222, never  
 16       once appears in the patent, nor does any similar description of film 222;
- 17       •       the Magni patent does not indicate that any special uncommon definition  
 18       should be given to the modifier “ribbon-shaped”;
- 19       •       the ordinary meaning of the phrase “ribbon-shaped film,” as supported by  
 20       various dictionaries defining “ribbon,” is “a long, narrow-strip of film  
 21       resembling a thin line;”
- 22       •       when the Magni patent uses phrase “ribbon-shaped string,” the term  
 23       “ribbon-shaped” means “having a long, narrow shape resembling a thin  
 24       line;”
- 25       •       the Magni patent repeatedly uses the adjective “ribbon-shaped” to describe  
 26       the shape of the film after it is cut from the spool and wrapped around the  
 27       evacuated tube;<sup>3</sup>
- 28       •       Zinus’ own President verified that he understood the term “ribbon-shaped”  
 29       to mean “significantly longer than it is wide,” and testified that in his view  
 30       the rectangular sheet of fabric in which Zinus rolls up its compressed  
 31       mattresses (which is slightly wider than the width of the mattress and

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 33       <sup>2</sup> Evidentiary citations for these points are set forth in Dreamwell’s opening Hypothetical  
 34       Claim Brief.

35       <sup>3</sup> As noted in Zinus’ initial Hypothetical Claim Brief, under Zinus’ interpretation of the  
 36       Magni “ribbon-shaped film” as film that is wide as the mattress, for a queen-sized bed, the length  
 37       of the film would only be approximately 2.5 times greater than the width of the film/mattress. It  
 38       is hard to imagine any definition of the term “ribbon-shaped” that would cover film of these  
 39       dimensions. Certainly, a film with these relative dimensions would not satisfy Zinus’ own  
 40       understanding of the term “ribbon-shaped,” as reflected in the testimony of its President.

appears to be roughly three times as long as it is wide) is *not* “ribbon-shaped”; and

- Figure 13 of the Magni patent discloses a series of narrow, parallel lines that criss-cross in some places, and could be viewed as multiple convolutions of a narrow, ribbon-shaped film. At a minimum, a reasonable finder of fact could infer from this evidence that Dreamwell's interpretation of the Magni patent disclosures is the correct interpretation. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1570-71 (Fed. Cir. 1991) (in assessing a summary judgment motion, the evidence must be viewed in the light most favorable to the opponent of the motion, all doubts must be resolved in favor of the opponent, and all inferences must be drawn in favor of the opponent).

Zinus continues to point to other evidence (i.e., its new discussion of Figure 14 of the Magni patent)<sup>4</sup> that supposedly supports its interpretation of the Magni patent’s disclosures. But Zinus has not disputed and cannot dispute that interpretation of the disclosures of a prior art reference is a question of fact. *See Jurgens, supra*, 927 F.2d at 1560 (“What a reference teaches is a question of fact for the jury to decide....”). Therefore, even if Zinus offers evidence that points to a contrary interpretation of the Magni patent than that proffered by Dreamwell, such evidence merely creates a factual dispute that would prevent this court from summarily adjudicating the disclosures of the Magni reference (and thus from deciding on summary judgment whether the hypothetical claim would be anticipated or rendered obvious by such prior art). *See, e.g., Bose, supra*, 98 F. Supp. 2d 80 (denying defendant’s motion for summary judgment on ensnarement defense where parties disputed the disclosures of prior art references); *Wright Medical, supra*, 1999 WL 130578 (D. Mass. 1999) (same)

Although Zinus' Opposition ignores most of the evidence cited by Dreamwell in support of Dreamwell's position that the Magni patent does not disclose a solid cover or barrier of material that substantially covers the exposed surface of the mattress assembly, Zinus *has*

<sup>4</sup> Zinus' assertion that the discussion of this Figure in the Magni patent explains why film 222 is as wide as or wider than the mattress is based solely on the unsupported "technical" analysis of Zinus' counsel. With all due respect, whether "film 222 cannot be a narrow strand because the holes would not create suction with a narrow strand," and whether the semi-mandrels 207 (or guide means 224, which is not discussed in this context in Zinus' papers) is capable of moving laterally with respect to the mattress, is more appropriately the subject of expert testimony, and should not be resolved in the context of this early, pre-claim construction motion.

1 attempted to address a small subset of that evidence. Zinus' arguments regarding that evidence,  
 2 however, merely highlight additional disputed issues of fact.

3 In particular, Zinus again criticizes Dreamwell's interpretation of Figure 13 of the Magni  
 4 patent, going so far as to accuse Dreamwell of deliberately "fabricating" an issue of material fact.  
 5 But as Dreamwell has previously observed, it is difficult to ascertain exactly what Figure 13 is  
 6 supposed to disclose. Rhetoric aside, Zinus has not addressed Dreamwell's explanation that in  
 7 addition to the checkerboard patterned lines marking the pattern of the mattress, Figure 13 shows  
 8 another series of narrow, parallel lines that criss-cross in some places. This latter series of lines  
 9 could be read to represent multiple convolutions of the ribbon-shaped film. Thus, even if the  
 10 Court credits the unsupported statement of Zinus' counsel that the dashed line leading to label C  
 11 is a "standard technical drafting convention" meaning that "mattress [sic] C is beneath film 222,"  
 12 that statement is not necessarily inconsistent with Dreamwell's position. Indeed, the volume of  
 13 argument advanced by the parties regarding the proper interpretation of Figure 13, and the  
 14 absence of any description in the patent that would provide definitive guidance regarding the  
 15 meaning of that drawing, demonstrates the ambiguity in this figure and the impropriety of trying  
 16 to resolve this ambiguity on summary judgment.

17 Finally, while Zinus argues in footnote 7 that Dreamwell has improperly applied the  
 18 doctrine of claim consistency with respect to the terms "ribbon-shaped film" and "ribbon-shaped  
 19 strings," it is actually Zinus that has misapplied the doctrine. Zinus starts by properly stating the  
 20 relevant legal principle, noting that "usage of a term in one place provides guidance regarding the  
 21 meaning of the same term in other places." *See also Phillips v. AWH Corp.*, 415 F.3d 1303, 1314  
 22 (Fed. Cir. 2005) (en banc), *cert. denied*, 126 S. Ct. 1332 (2006). Zinus goes on, however, to  
 23 assert that Dreamwell inconsistently uses "ribbon shaped" in connection with "film" and  
 24 "strings". To the contrary, Dreamwell contends that "ribbon-shaped" should be given the *same*  
 25 definition in the phrase "ribbon-shaped film" as it is given in the phrase "ribbon-shaped strings."  
 26 It is clear from the discussion and drawings in the Magni patent that "ribbon-shaped," as used in  
 27 the context of "ribbon-shaped strings," means "having a long, narrow shape resembling a thin

1 line.” Under the doctrine of claim term consistency, “ribbon-shaped” should be given the same  
 2 definition in the context of the phrase “ribbon-shaped film.”

3 In sum, Dreamwell has proffered evidence from which a trier of fact could conclude that  
 4 the Magni patent does not disclose a solid cover or barrier of flexible material that substantially  
 5 covers the exposed surfaces of the compressed mattress. *See Scripps, supra.* Zinus has not  
 6 disputed that if Dreamwell’s interpretation is correct, the hypothetical claim is non-obvious over  
 7 the Magni patent. At the very least, the evidence and argument submitted by Dreamwell creates a  
 8 genuine issue of material fact with respect to the facts underlying an obviousness determination  
 9 that prevents the Court from entering summary judgment of non-infringement based on Zinus’  
 10 “practicing the prior art” defense.

11       3.       **The Hypothetical Claim’s Specification of the Cover or Barrier**  
 12       **as Pre-Cut is Not Disclosed in the Magni Patent and, When**  
 13       **Considered as Part of the Claim as a Whole, is Not Obvious in**  
 14       **Light of that Prior Art.**

15       Zinus has created a straw man definition for the term “pre-cut” as used in Dreamwell’s  
 16 proposed hypothetical claim, and has then attempted to knock down that straw man by arguing  
 17 that “the nebulous ‘pre-cut’ limitation does not distinguish Magni because Magni discloses that  
 18 film 222 is pre-cut.” According to Zinus, “one end of film 222 is always ‘pre-cut’ before it is  
 19 rolled up together with a flattened mattress.” But that makes no sense. Under Zinus’  
 20 interpretation of Dreamwell’s hypothetical claim term, “pre-cut” means that the film is cut on one  
 21 end. But if that were so, then any film would be pre-cut, unless it was of infinite length. With all  
 22 due respect, that argument is preposterous. Obviously, “pre-cut” in the context of the  
 23 hypothetical claim means that *both* ends of the solid cover or barrier of material are cut before the  
 24 compressed mattress is inserted into or positioned within it.

25       As a fallback position, Zinus suggests that it would have been obvious to one of ordinary  
 26 skill reading the Magni patent to use a pre-cut cover or barrier of flexible material rather than the  
 27 spool of ribbon-shaped film disclosed in the Magni patent. That argument, however, is based  
 28 solely on the unsupported assertions of Zinus’ counsel; no *record evidence* supports it. In fact, it

1 is hard to imagine how one of ordinary skill, faced with the mechanized process of the Magni  
 2 patent, would think to replace the spool of ribbon-shaped film mounted on pressing and rolling  
 3 machine 45 with pre-cut pieces of ribbon-shaped film. To do so, one of ordinary skill would need  
 4 to decide to change the material in which the mattress is rolled up from a long, narrow strand of  
 5 film to a cover or barrier of material that is roughly as wide as the mattress.<sup>5</sup> He or she would  
 6 need to further change the material from a continuous roll of film to pre-cut sheets of film. And  
 7 he or she would also need to eliminate rolling up and pressing machine 45 altogether, as it is  
 8 clearly not designed for use with individual pre-cut covers or sheets of material. In other words,  
 9 the entire structure for containing the compressed mattress would have to be fundamentally  
 10 altered, as would the steps for implementing a containment structure. Dreamwell submits that  
 11 there is nothing in the Magni patent (or elsewhere in the prior art) that would suggest such a  
 12 dramatic change to the process. Certainly, the current state of the record would not support a  
 13 finding as a matter of law that such modifications would have been “obvious.”

14       B.     **There Are Disputed Issues of Fact Relating to Secondary**  
 15       **Considerations of Non-Obviousness.**

16       Zinus has not disputed and cannot dispute that Dreamwell offered evidence in the form of  
 17 the Declaration of Ricky Gladney showing that applying the patented packaging steps to  
 18 individual pocketed coil mattress assemblies was non-obvious and would produce unexpected  
 19 results. [Wilson Decl., Exh. 10] Zinus also does not dispute the existence of such evidence can  
 20 be sufficient to warrant denial of Zinus’ summary judgment motion. *See Monarch Knitting*  
 21 *Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 884 (Fed. Cir. 1998) (evidence that a  
 22 patented invention yielded unexpected results created a disputed issue of fact sufficient to warrant  
 23 denial of a motion for summary judgment of obviousness).

24       Instead, Zinus brushes off this evidence, asserting (as it did with the pocketed coil  
 25 limitation that is present in the hypothetical claim but not in the Magni patent) that “the Examiner  
 26

27       <sup>5</sup> This assumes that Dreamwell’s interpretation of the Magni patent is correct. Even under  
 28 Zinus’ interpretation of the Magni patent disclosures, all the other changes discussed in this  
 paragraph would be required.

1 rejected this argument in the original prosecution.” [Opposition at p. 8] Once again, the  
 2 prosecution history does not support Zinus’ argument.

3 In the Patent Office’s March 26, 1996 Office Action, the Examiner did state generically  
 4 that “Applicant’s arguments filed 1/22/96 have been fully considered but are not deemed to be  
 5 persuasive,” but the Examiner made no mention of the contemporaneously filed Gladney  
 6 Declaration or the facts set forth in that Declaration. In response to that Office Action, the  
 7 inventors submitted a new amendment including various modifications to the claims and  
 8 accompanying argument to traverse the prior rejection. Among other things, the inventors stated:

9 “Applicants note with some concern that no mention is made in the  
 10 instant Office Action of the previously filed Rule 132 Declaration  
 11 of inventor Rickey F. Gladney setting forth specific] technical data  
 12 consisting of the results of a comparative analysis of Broyles-type  
 13 springs versus applicants’ pocketed coils springs in compressibility  
 14 testing. These tests are believed to factually demonstrate the  
 15 unexpected results obtainable in compressing applicants’ pocketed  
 16 coil springs. It is respectfully submitted that this Declaration  
 17 should be given weight in the present situation of an obviousness-  
 18 type rejection as a secondary consideration of patentability.”

19 [Wallace Decl. Exh. W-F]

20 The next substantive action by the Patent Office was a Notice of Allowability in which the  
 21 claims were allowed without further comments. *[Id.]* Thus, while it is possible that the reason  
 22 for allowance was one or more of the amendments,<sup>6</sup> it is also possible that (a) the claims were  
 23 allowed because the Examiner revisited the Gladney Declaration as requested by the applicants  
 24 and recognized that it presented substantial evidence of non-obviousness that warranted  
 25 allowance of the claim, or (b) the claims were allowed due to a combination of the amendments

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<sup>6</sup> Remarkably, Zinus argues that the reason the claims were allowed was the addition of  
 the final two method steps, which relate to removing the mattress from the evacuation tube and  
 letting it return to its uncompressed state. Dreamwell uses the term “remarkably” because in its  
 Motion for Reconsideration, Zinus argued vociferously that it was the additional of the “for  
 shipment” limitation in the containment sleeve that led to the issuance of the claims. The reality  
 is that the final Amendment contained changes to the pocketed coil limitation and to the  
 containment sleeve element, it added the final two method steps, and that it sought  
 reconsideration of the Gladney Declaration. The Patent Office did not specify which of these  
 modifications justified allowance of the claims. [Wallace Decl., Exh. W-F]

1 and the Gladney Declaration. At a minimum, the Gladney Declaration cannot be summarily  
 2 rejected as Zinus has proposed. *See Tyler Refrigeration, supra.*

3 In sum, given the numerous disputed issues of fact, it would be inappropriate for the court  
 4 to conclude as a matter of law at any point -- let alone at this early point in the case -- that the  
 5 Patent Office would have found the hypothetical claim obvious in light of the Magni prior art.  
 6 *See Mars, supra.*

7 **II. THE PROPOSED HYPOTHETICAL CLAIM IS NOT INVALID UNDER 35  
 8 U.S.C. § 112 BECAUSE THAT STATUTE HAS NO APPLICABILITY TO A  
 HYPOTHETICAL CLAIM ANALYSIS.**

9 Without offering any legal authority or other support, Zinus asserts that Dreamwell's  
 10 proposed hypothetical claim must be rejected because certain of the language added to the  
 11 hypothetical claim would render the claim unpatentable under 35 U.S.C. § 112. Zinus cites no  
 12 authority because there is no legal basis for Zinus' assertion that Section 112 has any relevance to  
 13 a hypothetical claim analysis. *See Wright Medical, supra*, 1999 WL 130578.

14 Certainly *Wilson Sporting Goods*, the first case to apply a hypothetical claim analysis,  
 15 does not suggest that Section 112 is relevant to that analysis. In that case, the Federal Circuit held  
 16 that a district court should ascertain whether there is a hypothetical patent claim that is "sufficient  
 17 in scope to literally cover the accused product" and that "could have been allowed by the PTO  
 18 *over the prior art.*" *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, 904 F.2d 677,  
 19 684 (Fed. Cir. 1990) (emphasis added). Similarly, in the *Streamfeeder* opinion cited in the  
 20 Court's Interim Order, the Federal Circuit noted that the patentee's burden in a hypothetical claim  
 21 analysis is "to show that its claim does not cover the prior art;" there is no reference to Section  
 22 112. *Streamfeeder, LLC v. Sure-Feed Systems, Inc.*, 175 F.3d 974, 983 (Fed. Cir. 1999)  
 23 (emphasis added). Likewise, in *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d  
 24 1371 (Fed. Cir. 2001), cited at page 2 of Zinus' Hypothetical Claim Opposition Brief, the Federal  
 25 Circuit held that if a hypothetical claim "would be unpatentable **under 35 U.S.C. §§ 102 or 103**,  
 26 then the patentee has overreached," and the doctrine of equivalents cannot be applied to the  
 27 accused product or method. *Id.* at 1380 (emphasis added). None of these cases suggest that the

1 court must also determine whether the hypothetical claim would be patentable under 35 U.S.C. §  
 2 112.

3       Indeed, the only court to address this issue has clearly and directly held that Section 112  
 4 has no applicability to a hypothetical claim analysis. In *Wright Medical Technology, Inc. v.*  
 5 *Osteonics Corp.*, 1999 WL 130578 (D. Mass. 1999), defendant Osteonics moved for summary  
 6 judgment of non-infringement based on the doctrine of equivalents, arguing (as Zinus argues  
 7 here) that a hypothetical claim that would literally cover its device would be invalid under the  
 8 written description requirement of 35 U.S.C. § 112. The district court correctly rejected this  
 9 argument, noting that “the ‘written description’ requirement imposed by 35 U.S.C. § 112 . . . is  
 10 not intended to be part of the analysis of infringement by equivalents.” The court further noted  
 11 that “Osteonics candidly acknowledges that it is aware of no case that has applied § 112’s written  
 12 description requirement to a claim hypothesized as suggested (for a different purpose) by *Wilson*  
 13 *Sporting Goods.*”

14       The *Wright Medical* court went on observe that “[i]n effect, Osteonics is suggesting that a  
 15 patent might contain a sufficient written description to support the claims literally set forth, but  
 16 nevertheless insufficiently describe a different device, not literally claimed, that is accused of  
 17 being a substantial equivalent of the patented invention.” As the court persuasively reasoned,  
 18 “[t]his proposition not only has no authoritative support, but also runs counter to what the  
 19 Supreme Court has said about the doctrine of equivalents. *See Warner-Jenkinson Co. v. Hilton*  
 20 *Davis Chemical Co.*, 520 U.S. 17 (1997). There, in addition to emphasizing what must be shown  
 21 to establish infringement by equivalents, the Court pointed out that it was not necessary to  
 22 proving infringement to show that the patent disclosed equivalents to the invention. *Id.* at 1053  
 23 (rejecting the proposition that equivalents must ‘be actually disclosed in the patent in order for  
 24 such equivalents to infringe upon the patent’). The patent’s written description must support what  
 25 is disclosed; there is no reason to require description of what need not be disclosed.” *Wright*  
 26 *Medical, supra.*

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1 In sum, the law is clear: the hypothetical claim framework does not involve an analysis of  
2 whether such a claim would be patentable under the written description requirement of 35 U.S.C.  
3 § 112. Zinus' attempt to strike Dreamwell's proposed hypothetical claim based on a Section 112  
4 analysis should be summarily rejected.

## **Conclusion**

6 For the foregoing reasons, Zinus' request for a summary adjudication of non-infringement  
7 based on its "ensnarement" or "practicing the prior art" arguments must be denied.

9 || Dated: February 12, 2008

PERKINS COIE LLP

By \_\_\_\_\_ /s/  
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